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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,386	12/01/2000	Tadakatsu Shimada	PM 275953 SH-0022US	3958
909 7580 12/02/2003				
PILLSBURY WINTHROP, LLP				
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EXAMINER				
HOFFMANN, JOHN M				
ART UNIT		PAPER NUMBER		
1731				

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,386

Applicant(s)

SHIMADA ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 23.50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 23.50 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

The amendment filed 10-24-03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The inequality of paragraph 00171.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17, 23 and 50-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17, line 3 isn't understood. It is unclear if it requires that the bar material is the base material, or if it requires a step of depositing base material on the bar material, or if the base material is already on the bar. Additionally/alternatively, there is no antecedent basis for "the base material"; although the preamble mentions the method is "for" manufacturing the base material, there is no explicit step of its creation and this would leave one of ordinary skill uncertain as to the scope of the claim.

Claims 50-51: there is no antecedent basis for "the holding member". At first look, claim 17 seems to indicate that the support member may be the holding member because it holds the bar material. However, when looking at claim 51, it is clear that the holding member/roller is distinct from the supporting member.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 50-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for the holding members of claims 50-51. There is no mention of any "holding member" in the present specification.

Claim Rejections - 35 USC § 102

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Tsuchiya 5624474.

Looking to figure 4 and elsewhere: 50 is the support member which is one unit. 38 and/or 44 is the bar material that is held by the support member. As to the depositing of material: see col. 3, lines 12-13 and col. 1, lines 14-40. As to the rotating of the bar material, see col. 4, lines 44-60. and col. 7, Line 1. The radial movement is regulated to near zero- see abstract line 14. 56, 54 and 57 comprise the swing suppressing mechanism: it contacts the bar material 50 in a perpendicular direction in as much as Applicant's invention does.

Claim Rejections - 35 USC § 103

Claim 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya.

Tsuchiya does not disclose any sintering of the preform. It would have been obvious to sinter the soot body into glass and then draw it into a fiber, because that is its intended use. It would have been further obvious to perform the Tsuchiya process at multiple locations simultaneously, so that one can make multiple preforms. It would have been further obvious to have the multiple processes occurring in the same general area/building so that one expert could monitor all of them effectively. While one preform is being sintered in a first machine, it would be near a "sintering area" of a second machine. There would be sintering in each machine. It would have been obvious to keep it in that location for the entire sintering process - because any unnecessary movement of the apparatus might induce detrimental movements or

Art Unit: 1731

temperature shocks to the operation. And making the apparatus move, would just require extra cost and/or effort to make it movable, to move it, and provide space to move it to. The maintaining step is deemed to only require that the preform stay in the same location from the instant it arrives at the sintering furnace - until it is heated up to a temperature which will sinter it. It is noted that the claim does not specify what is sintered.

Claims 50-51: it is deemed that Tsuchiya meets the claims in as much as the present invention does. As can be seen from figures 3-4, the inner surfaces of 56 and 54 are concave, The bearings are spherical rollers.

Response to Arguments

Applicant's arguments filed 10-24-03 have been fully considered but they are not persuasive.

It is argued that there is an obvious error in paragraph 00171. There is no indication as to why the error was an obvious error. Further more there is no indication that one skilled would recognize the appropriate correction for the alleged error. An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction. In re Oda, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

It is argued that the bearings of Tsuchiya do not make contact with the starting rod 44. The relevance is not understood: the claims do not require a starting rod, thus Tsuchiya does not need to show such.

It is further argued that rod 38 is not constituted as a single unit. Examiner does not agree; there is no reason not to consider any thing or any combination of things to not be a unit. A unit can have many different features - either connected or not. In re Larson 144 USPQ 347 (CCPA 1965) held- While the brake disc and clamp of Tuttle et al. comprise several parts, they are rigidly secured together as a single unit. The constituent parts are so combined as to constitute a unitary whole--. It is deemed that any combination of features can be deemed to be a "unit". Moreover it is noted that most preforms have glasses of two or more compositions: thus one must not limit features (with more than one components) so that they are not "units".

Re claim 23: As per the above rejection, Examiner disagrees with the conclusion that all of the features are not shown. **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

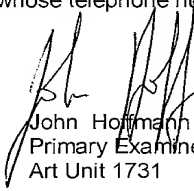
Art Unit: 1731

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


John Hoffmann
Primary Examiner
Art Unit 1731

11-25-03

JMH